

REMARKS

By the present response, claims 31-48 and 50-68 are now in the application. No claims have been added or amended. Reconsideration of the rejection of claims 31-48 and 50-68 and allowance of the same are requested.

All of the pending claims have been rejected under the judicially created doctrine of double patenting in view of pending claims 13-30 in co-pending U.S. Patent Application 09/833,593. In response, a terminal disclaimer is enclosed. As noted by the Office Action, this obviates the double patenting rejection.

The pending claims have also been rejected under *In re Schneller*. Applicants' representatives have appealed two *In re Schneller* rejections within the last several years. The first appeal was *Ex parte Davis*, a precedential opinion which expressly held that *In re Schneller* is limited to its facts. *Ex Parte Davis*, 56 U.S.P.Q. 1434 (Bd. Pat. App. & Int. 2000). Shortly after *Ex parte Davis*, MPEP 8.38 was amended to expressly state an *In re Schneller* rejection "**will be rare**" (emphasis in MPEP), and that no Examiner may issue a rejection under *In re Schneller* without first obtaining the approval of the Technology Center Director. Applicants request that the Examiner confirm that TC Director approval has been given for this *In re Schneller* rejection, as no such indication appears in the Office Action. Absent such authorization, the rejection is not yet ripe, and a substantive response on the merits would be premature.

The second appeal was *Ex Parte Sobelman* (copy enclosed), which the board remanded because the Examiner has not provided a side by side comparison of **each** claim in one case with **each** claim of the other co-pending case. In the instant

application, that would require a side by side comparison for every combination of all 37 pending claims in the instant application against all pending 27 claims in the co-pending application - a total of 999 comparison charts. While *Ex Parte Sobelman* is not precedential, it aptly demonstrates how the Board of Appeals responds to *In re Schneller* rejections.

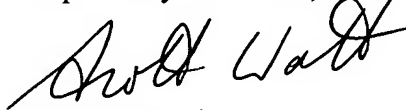
Applicants submit that the relative rarity of *In re Schneller* rejections, as emphasized by the legal and administrative hurdles to enter one, suggest that it is not an appropriate rejection for the instant application.

In view of the foregoing, the application is now believed to be in proper form for allowance, and a notice to that effect is earnestly solicited.

If a telephone conference would be of value, the Examiner is requested to call the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge/credit any fee deficiencies or overpayments to Deposit Account No. 19-4293 (Order No. 15047.4007).

Respectfully submitted,



Scott D. Watkins
Reg. No. 36,715

Date: January 3, 2006

Steptoe & Johnson LLP
1330 Connecticut Avenue, NW
Washington, DC 20036
Tel: 202-429-3000
Fax: 202-429-3902



The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD E. SOBELMAN and KARL M. FANT

Appeal No. 1999-2378
Application No. 08/867,675

HEARD: Sept. 18, 2002

MAILED

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before KRASS, JERRY SMITH, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

REMAND TO EXAMINER

A patent examiner rejected claims 5-7, 9-11, 13-15, and 17-19. The appellants appeal therefrom under 35 U.S.C. § 134(a). We remand.

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard [of Patent Appeals and Interferences] to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after

considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Braeken*, 54 USPQ2d at 1112.

The examiner bases his rejections on a "judicially created doctrine of double patenting. . . ." (Final Rejection at 2.¹) Specifically, he relies on the doctrine to reject claims 5-7, 9-11, 13-15, and 17-19 over claims 1-20 of U.S. Patent No. 5,640,105 (the "'105 Patent") and over claims 1-28 of U.S. Patent No. 5,656,948 (the "'948 Patent"). (*Id.*) He cites *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA, 1968) and M.P.E.P. § 804 in support of the doctrine. (*Id.* at 3.)

Schneller, however, applies only to those situations where the following conditions are satisfied. (1) The subject matter recited in a claim of a patent application is fully disclosed in and is covered by a claim in a patent (i.e., there has been no improvement or modification invented after filing and the application claim reads on subject matter protected by a patent claim). (2) There is no reason an appellant was prevented from presenting the same claim for examination in the issued patent (i.e., there is no justification for extending the protection, such as the existence of a

¹We advise the examiner to copy his rejections into his examiner's answers rather than merely referring to a "rejection set forth in the prior Office Action." (Examiner's Answer at 3.)

restriction requirement). See *Schneller*, 397 F.2d at 355, 158 USPQ at 215; M.P.E.P. § 804 (7th ed., July 1998).

Here, the examiner fails to show satisfaction of either condition. First, he fails to show that the subject matter recited in claims 5-7, 9-11, 13-15, and 17-19 of the instant application is covered by claims 1-20 of the '105 Patent and claims 1-28 of the '948 Patent. Regarding the requirement for claim coverage, M.P.E.P. § 804 (7th ed., July 1998) included the following provision at the time of the examiner's answer.

In determining whether to make this type of nonstatutory double patenting rejection, the examiner should do a side by side comparison of the reference and application claims, keeping in mind that "only the claims of the patent can be considered as support for the rejection, its disclosure being looked to only to determine the meaning of the claims, which are to be read in the light of the specification." 397 F.2d at 352, 158 USPQ at 213.

Here, no such side by side comparison appears in the examiner's explanation of the rejections. He merely makes the following allegations.

The subject matter claimed in the instant application is fully disclosed in the patent[s] and is covered by the patent[s] since the patent[s] and the application are claiming common subject matter, as follows: plurality of n input signal lines, each line having asserted state and NULL state; an output signal line; hysteresis circuit; assertion (triggering) means; switching means/circuitry; etc.

(Final Rejection at 2-3.)

Second, the examiner fails to show that there is no reason the appellants were prevented from presenting each of claims 5-7, 9-11, 13-15, and 17-19 for examination in the '105 Patent and the '948 patent. He merely concludes, "there is no [such] apparent reason. . . ." (*Id.* at 3.)

"We decline to substitute speculation as to the rejection[s] for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejections." *Gambogi*, 62 USPQ2d at 1212. Instead, we remand the application to the examiner to reconsider the propriety of his rejections in view of the aforementioned conditions and requirements. In doing so, he should consider the analytical basis for the Board's decision *Ex parte Davis*, 56 USPQ2d 1434 (Bd.Pat.App. & Int. 2000).


If after such reconsideration, the examiner believes an obviousness-type double patenting rejection is still proper, we need a full explanation of how each condition and each requirement is satisfied. In particular, we need a side by side comparison of **each** of claims 5-7, 9-11, 13-15, and 17-19 of the instant application with **each** of claims 1-20 of the '105 Patent and **each of** claims 1-28 of the '948 patent.

For the aforementioned reasons, the application is remanded to the examiner for further action not inconsistent with the views expressed herein. Any supplemental examiner's answer submitted by the examiner should be self-contained with respect to all rejections and arguments; no prior answer or Office action should be referenced or incorporated therein. Similarly, any supplemental brief submitted by the appellants should be self-contained with respect to all arguments. No prior briefs or papers should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).


ERROL A. KRASS
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge


LANCE LEONARD BARRY
Administrative Patent Judge

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Application No. 08/867,675

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STUART T F HUANG
STEPTOE AND JOHNSON
1330 CONNECTICUT AVENUE N W
WASHINGTON, DC 20036